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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN MARK SHUSTER and GARY STEPHEN SHUSTER

Appeal 2007-3031
Application 09/648,474
Technology Center 2100

Decided: February 25, 2008

Before HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD, and JEAN R. HOMERE, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 50-69. We have jurisdiction under 35 U.S.C. § 6(b), 134(a).

We reverse, and enter a new ground of rejection in accordance with 37 C.F.R. § 41.50(b).

Appellants' invention relates to a method for hosting information exchange groups on a wide area network. (Abstract.) Claim 50 is the sole independent claim on appeal:

50. A method for exchanging information within a group of users on a wide area network, comprising the steps of:

serving a topically organized information resource over the wide area network, the information resource comprising a defined topic of information, posts of information from users, and a plurality of links to respective different remote information resources each containing information related to the topic;

receiving user ratings from the users, the user ratings signifying relevance of respective ones of the posts and of the remote information resources to the defined topic, the user ratings determined by respective ones of the users after reviewing respective ones of the posts and of the remote information resources;

aggregating the user ratings to provide aggregate relevance ratings data; and

providing access to the aggregate ratings data in association with the posts of information and with the plurality of links.

The Examiner relies on the following references as evidence of unpatentability:

Rose	US 5,724,567	Mar. 3, 1998
Herz	US 6,460,036 B1	Oct. 1, 2002 (filed Dec. 5, 1997)

Claims 50-69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herz and Rose.

Claims 1-49 have been canceled.

I. The standing rejection

Because we do not consider the requirements of at least independent claim 50 to be as restrictive as the Examiner's interpretation of the claim, we will not address the points of contention between the Examiner and Appellants. We reverse, *pro forma*, the standing rejection because we begin with a different interpretation of the claims than that upon which the rejection is based.

II. New Ground of Rejection

We reject claim 50 under 35 U.S.C. § 102(b) as being anticipated by Rose. Because we are basically a board of review and do not examine applications in the first instance, we will address claim 50 as representative of the invention and limit the rejection to that claim.

Appellants' claim 50 provides, and Rose describes, the following.

> *50. A method for exchanging information within a group of users on a wide area network, comprising the steps of:*

Rose describes a method for exchanging information within a group of users on a wide area network (col. 3. ll. 52-55). Rose refers to the "information" as "messages," but defines "messages" broadly. A "message" refers to each item of information that is provided by and accessible to users of the system. Examples include a note addressed from one user to another,

a textual and/or graphical document, a video clip, or a software data structure. Rose col. 3, ll. 18-35.

> *serving a topically organized information resource over the wide area network,*

The "serving" refers to delivery of a page to a user's computer (e.g., item 136 in instant Fig. 1B).

Rose describes delivery of a topically organized page to a user's computer (e.g., Fig. 3; col. 4, ll. 45-62).

> *the information resource comprising a defined topic of information, posts of information from users, and a plurality of links to respective different remote information resources each containing information related to the topic;*

The "plurality of links" is the only recitation in this clause that relates to machine function, other than the mere display of data. The "defined topic of information" and the identity of the other "information" (posts from users) refer to the information that is displayed to the user. As such, the "information" is a mere arrangement of data on a display -- i.e., nonfunctional descriptive material. The content of the nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. *Cf. In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) ("Lowry does not claim merely the information content of a memory. . . . [N]or does he seek to patent the content of information resident in a database."). *See also Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed.

Cir. Appeal No. 2006-1003, *aff'd* Rule 36 Jun. 12, 2006); *Ex parte Mathias*, 84 USPQ2d 1276 (BPAI 2005) (nonprecedential) (*aff'd* 191 Fed. Appx. 959 (Fed. Cir. 2006)); *Manual of Patent Examining Procedure* § 2106.01 (8th ed., Rev. 6, Sept. 2007).

Rose discloses data arranged on a computer display (e.g., Fig. 3). The user interface includes a plurality of links to respective different remote information resources (col. 5, ll. 10-17), which results in retrieval of the information shown in Figure 4.

> *receiving user ratings from the users, the user ratings signifying relevance of respective ones of the posts and of the remote information resources to the defined topic, the user ratings determined by respective ones of the users after reviewing respective ones of the posts and of the remote information resources;*

We also cannot read what the user ratings "signify" as being a meaningful limitation on the claimed method. By the terms of the claim, the "user ratings" are generated by human beings. That the data is considered to signify "user ratings" does not functionally change the data storage or the computers used in the method of claim 50. The computer that receives the user ratings cannot discriminate what the user regards the data to represent, but only that a number (for example) has been entered. The mental steps that might precede entry of the number are irrelevant to the number that is entered, so far as machine function is concerned.

Moreover, if we were to give weight to what the human is thinking when the human enters a "rating," the claim would raise significant issues with respect to whether one may ascertain the metes and bounds of the invention. Our reviewing court has held that the recitation of "aesthetically pleasing" in a claim rendered the claim indefinite under 35 U.S.C. § 112, second paragraph, as opposed to objectively verifiable subject matter that is not dependent on a particular person's subjective opinion. *See Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 1356 (Fed. Cir. 2005). In the instant case, how could the computer (or even an observing person) know that a user is entering data consistent with the user's thought process? The receiving of data from users is a limitation on the subject matter of claim 50. What the data might represent to the user who enters the data -- "user ratings" -- is not objectively verifiable subject matter, but is dependent on the user' subjective opinion -- even assuming that the user does not lie.

Rose describes receiving user ratings from the users. Col. 5, ll. 36-59; Fig. 4.

aggregating the user ratings to provide aggregate relevance ratings data;

Appellants define an "aggregate" as "any statistical measure that reflects the overall value of a set of quantitative ratings, such as a sum, a weighted average, a simple average, a rolling average, a median value, or similar measure." (Spec. 32: 24-26.)

Rose describes aggregating the user ratings to provide aggregate relevance ratings data. Col. 6, l. 4 - col. 7, l. 62.

providing access to the aggregate ratings data in association with the posts of information and with the plurality of links.

Rose describes providing access to the aggregate ratings data in association with data arranged on the display and the plurality of links. Rose Figure 3, for example, provides access to the user by means of display of the relative ranking score (28) of each message. Rose col. 4, ll. 45-62.

We therefore find instant claim 50 to be anticipated by Rose.

The Board of Patent Appeals and Interferences is a review body, rather than a place of initial examination. We have made a rejection above under 37 C.F.R. § 41.50(b). However, we have not reviewed claims 51-69 to the extent necessary to determine whether these claims are unpatentable over Rose and other prior art cited in the record. In the event that Appellants do not file an amendment that overcomes the new ground of rejection, we leave it to the Examiner to reject any dependent claims deemed to be unpatentable over Rose, or over Rose in combination with other prior art.

CONCLUSION

The Examiner's rejection of claims 50-69 under 35 U.S.C. § 103(a) as being unpatentable over Herz and Rose is reversed.

A new rejection of claim 50 under 35 U.S.C. § 102(b) over Rose is set forth herein.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2007). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REVERSED -- 37 C.F.R. § 41.50(b)

rwk

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